

REMARKS

Claims 1-16 were examined by the Office, and all claims are rejected. With this response claims 1, 4-10 and 13-15 are amended to correct informalities, place the claims in better form and to remove reference numerals. All amendments are fully supported by the specification as originally filed. Applicant respectfully requests reconsideration of the objections and rejections in light of the following discussion.

Claim Objections

Claim 4 is amended to replace the word “last” with “least” in order to correct informalities. Therefore, applicant respectfully requests withdrawal of the objection to claim 4.

Claim Rejections Under § 112

Claim 6 is amended to recite “said selected characters,” wherein said selected characters find antecedent basis in claim 1 in that displayed characters are selected by the user.

Claim 9 is amended to recite “generating the character subset,” which finds antecedent basis from the generating step recited in claim 1. Applicant respectfully requests withdrawal of the indefiniteness rejections in view of the amendments to claims 6 and 9.

Claim Rejections Under § 101

Claim 13 is amended to recite “a computer program product comprising a computer readable storage structure embodying computer program code thereon,” and therefore applicant respectfully submits that claim 13 recites a tangible medium for storage of the computer program product. As such, claim 13 is believed to be statutory.

Claim 14 is believed to be statutory, because claim 14 is amended to recite that the computer data signal is “embodied in a carrier wave and at least transiently stored in a computer readable storage structure.” Therefore, claim 14 is amended to recite a tangible embodiment of the computer data signal, because it is at least transiently stored in a computer readable storage structure.

Claim Rejections Under § 103

In section 10, on page 4 of the Office Action claims 1-3, 6 and 8-15 are rejected under 35 U.S.C. § 103(a) as unpatentable over Dutta et al. (U.S. Appl. Publ. No. 2002/0149569) in view of Will (U.S. Patent No. 6,392,640). Applicant respectfully submits that claim 1 is not disclosed or suggested by the cited references, either alone or in combination, because there is no motivation to combine the cited references, and therefore the cited references fail to disclose or suggest all of the limitations recited in claim 1.

The Office acknowledges on page 4 of the Office Action that Dutta does not teach that the user interface is a roller, wherein browse commands are issued by rotating the roller around its axis, and select commands are issued by pressing the roller, as recited in claim 1. Applicant respectfully submits that there is no motivation or suggestion to combine the roller of Will with the device disclosed in Dutta, because this combination would change the principle of operation of Dutta. See MPEP § 2143.01 (if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious).

Dutta is directed to an improved touchscreen keyboard that facilitates greater speed and ease of user input. See Dutta paragraph [0007]. Characters are entered by using a stylus to select characters from the touchscreen keyboard. See Dutta paragraph [0025]. Based on the entered characters, the personal digital assistant discussed in Dutta predicts potential candidates for the next entry, and presents the predicted candidates to the user in a prominent fashion. See Dutta paragraphs [0056] & [0057]; see also Figure 7 & paragraph [0039]. By prominently displaying the predicted next characters, it is easier for a user to find the next character to select when using the touchscreen. Dutta is specifically directed to providing a customizable touchscreen keyboard in which the predicted next characters may be displayed on the customized touchscreen keyboard.

In contrast to Dutta, Will discloses using a thumbwheel as a user interface for the selection and entry of text. There is no motivation to combine the teachings of Will with those of Dutta, because the addition of a thumbwheel to Dutta would destroy the purpose of Dutta of providing a customizable touchscreen keyboard for the selection of characters. In Dutta, characters are selected using the touchscreen, meaning that the user only need to make contact with the appropriate portion of the touchscreen to select and enter the desired character. If a

thumbwheel is added, the principle of operation of Dutta, i.e. using the customizable touchscreen keyboard to select characters, would be changed because the user would then have to scroll through the characters displayed on the keyboard to select a desired character. The character prediction system of Dutta is specifically directed to the use of touchscreen keyboards, because it provides for the display of predicted characters in a more prominent fashion. The addition of a thumbwheel would defeat the purpose of prominently displaying predicted characters, because the user would still have to scroll through the characters instead of simply pressing the touchscreen keyboard to select the characters. Therefore, one of skill in the art would not be motivated to combine the device and character prediction system disclosed by Dutta with the thumbwheel disclosed by Will. As such, the cited references fail to disclose or suggest all of the limitations recited in claim 1, and claim 1 is patentable over the cited references.

In addition, even Will by itself fails to disclose or suggest all of the limitations recited in claim 1. The character recognition and selection system discussed in Will is entirely different from the method recited in claim 1. Claim 1 recites a character subset of a character set is generated, and the character subset includes characters from which the next character of a word is most probably selected. In contrast to claim 1, Will discloses that a user enters the first few letters of a word ambiguously, i.e. by selecting a “character group,” and the system retrieves words consistent with the letters. See Will Abstract; column 4, line 66—column 5, line 1. Therefore, the user does not select a particular letter, but instead only a character group of letters of which include the desired letter. The system then proposes words that include combinations of letters that were within the character group. See Will column 6, lines 46-58. Therefore, Will fails to disclose or suggest generating a character subset of a character set that includes characters from among which the next character for a word is most probably selected, as recited in claim 1. Instead, Will only generates a group of words that correspond to the ambiguously selected characters within the character groups. The words are not a character subset, as recited in claim 1, because the words are not a subset of any of the “character groups,” since they contain characters from each character group. Furthermore, the proposed words are not a character subset from which the next character of a word can be selected by a user, because the user of the system of Will can only select one of the entire words. Therefore, for at least these reasons, the cited references, alone or combination, fail to disclose or suggest all of the limitations recited in claim 1.

Independent claim 15 contains limitations similar to those recited in claim 1, and is rejected for the same reasons as claim 1. Therefore, for at least the reasons discussed above in relation to claim 1, claim 15 is not disclosed or suggested by the cited references.

Claims 2-3, 6 and 8-14 ultimately depend from an independent claim, and are not disclosed or suggested by the cited references at least in view of their dependencies.

In section 11, on page 6 of the Office Action claims 4-5, 7 and 16 are rejected under 35 U.S.C. § 103(a) as unpatentable over Dutta in view of Will and further in view of Dostie et al. (U.S. Appl. Publ. No. 2004/0021691). Claims 4-5, 7 and 16 all ultimately depend from an independent claim, and are not disclosed or suggested by the cited references at least in view of their dependencies.

#### Conclusion

For at least the foregoing reasons, the present application is believed to be in condition for allowance, and such action is earnestly solicited. The undersigned hereby authorizes the Commissioner to charge Deposit Account No. 23-0442 for any fee deficiency required to submit this response.

Respectfully submitted,

Date: 26 March 2007

Keith. Ober

Keith R. Ober  
Attorney for Applicant  
Registration No. 58,051

WARE, FRESSOLA, VAN DER SLUYSEN  
& ADOLPHSON LLP  
Bradford Green, Building Five  
755 Main Street, P.O. Box 224  
Monroe, CT 06468  
Telephone: (203) 261-1234  
Facsimile: (203) 261-5676  
USPTO Customer No. 004955